

REMARKS

First note regarding pending claims

Claims 15-25 have been cancelled in this office action response, rendering claims 1-14 pending in the present patent application. Applicant is not conceding that claims 15-25 are unpatentable, and reserves the right to re-introduce these claims in one or more continuing patent applications.

Furthermore, Applicant respectfully requests that the cancellation of claims 1-14 be entered by the Examiner and explicitly acknowledged in an advisory action. The cancellation of these claims places the patent application in better condition for appeal, and does not require any further search or consideration on the part of the Examiner.

Second note regarding pending claims

Claims 1-14, including independent claims 1 and 13, have not been amended in this response. Therefore, the next office action has to be non-final if it is based on prior art not used by the Examiner in rejecting the claims. (See MPEP sec. 706.07(a))

Claim rejections under 35 USC 103

Claims 1-9 and 12 have been rejected under 35 USC 103(a) as being unpatentable over Hamilton (7,107,330) in view of Barmettler (2003/0023770). Claims 10, 13, and 14 have been rejected under 35 USC 103(a) as being unpatentable over Hamilton in view of Barmettler, and further in view of Platt (5,421,009). Applicant submits that as previously presented, the pending claims are patentable over Hamilton in view of Barmettler (and optionally in view of Platt), for at least three reasons, which are now discussed in detail.

First reason why claimed invention is patentable

All the pending claims have been rejected over a combination of references that include Hamilton. Hamilton was published on September 12, 2006, whereas the claimed invention was filed on March 14, 2004. Therefore, Hamilton is not a 102(b) reference, because it was not published more than one year before the filing of the present patent application. Rather, Hamilton is a 102(e) reference, because it is a patent that was granted based on a patent application that was filed before the present patent application was filed. Note that Applicant is not saying that the claimed invention was rejected under 35 USC 102(e), but rather that Hamilton is a 102(e) reference used in rejecting the claims under 35 USC 103(a).

Applicant submits that Hamilton was commonly owned with the present patent application at the time the invention of the present patent application was made, such that Hamilton cannot be considered prior art pursuant to 35 USC 103(c). Pursuant to the requirements promulgated under MPEP sec. 706.02(l)(2)II.,¹ Applicant provides the following section.

¹ This section of the MPEP states that the “statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) Applicants *may, but are not required to*, submit further evidence . . . in addition to the above-mentioned statement concerning common ownership. For example, an attorney . . . [i]n her response for Application X states, in a clear and conspicuous manner that ‘Application X and Patent A were made at the time the invention of Application X was made, owned by Company Z.’ This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 USC 103(a) against the claims of Application X.”

**COMMON OWNERSHIP OF US PATENT 7,107,330 AND PRESENT PENDING US
PATENT APPLICATION 10/800,975 AT THE TIME OF THE INVENTION OF PATENT
APPLICATION 10/800,975 WAS MADE**

Applicant hereby submits that US patent 7,107,330 and the present pending US patent application 10/800,975, at the time the invention of patent application 10/800,975 was made, were commonly owned by, and/or subject to an obligation of assignment to the same party, International Business Machines Corporation, of Armonk, N.Y.

Therefore, insofar as Hamilton is not properly considered prior art, the claimed invention is patentable – and Applicant traverses the rejection of the pending claims under 35 USC 103(a) – for this reason.

Second reason why claimed invention is patentable

The claimed invention is limited to a “master driver file” that has “entries for the drivers” created therein. Hamilton in view of Barmettler does not teach, disclose, or suggest this claim language. The Examiner has stated that column 3, lines 50-54 of Hamilton in particular disclose this aspect of the claimed invention. However, this excerpt of Hamilton states that:

A file is also created within the server computer system. Each client computer system selected to receive and install the device driver is listed within the file. The file includes multiple entries, *one for each client computer system* on which to install the device driver.

In the claimed invention, therefore, there is a master driver file in which entries are created for the drivers. By comparison, in Hamilton in view of Barmettler, the file in question has entries created therein for the client computer systems – not for the drivers. Each client computer system is listed within an entry created within the file in Hamilton in view of Barmettler, not each driver, in

contradistinction to the invention. For at least this reason alone, Hamilton in view of Barmettler does not render the invention *prima facie* obvious under 35 USC 103(a).

The Examiner has conducted a rather convoluted reasoning process on page 16, paragraph 33, of the final office action to conclude that Hamilton in this excerpt actually does disclose a master driver file that has entries for the drivers created therein, like the claimed invention. However, the Examiner's conclusion ultimately contradicts the plain teachings of Hamilton in view of Barmettler. Hamilton in view of Barmettler says explicitly that the (master driver) file includes multiple entries – one for each client computer system, and not one for each driver, as in the invention. To conclude otherwise, therefore, is to ignore the plain teachings of the claimed invention. Without employing impermissible hindsight in interpreting Hamilton, there is just no way that one of ordinary skill within the art would conclude that the teaching “the file includes multiple entries, one for each client computer system,” actually means “the file includes multiple entries, one for each driver.”

Indeed, the excerpt of Hamilton disclosed above references a *single* device driver, where you have a file in which there are multiple entries corresponding to the client computer systems on which this *single* device driver is to be installed. By comparison, the claimed invention is explicitly limited to a file in which there are entries for drivers (plural). Thus, at best, Hamilton in view of Barmettler can be interpreted to mean that you have a file in which there are multiple entries *for the same device driver* – not for drivers (plural), as in the claimed invention. Again, the prior art suggests what it suggests. To take the suggestion of Hamilton and twist it to satisfy the metes and bounds of the claim language is improper, especially where the end result of the twisting is that the original, explicit disclosure of Hamilton becomes lost.

Third reason why claimed invention is patentable

The claimed invention is limited to the “unattended installation file [being] a different file than the master driver file.” Hamilton in view of Barmettler does not teach, disclose, or suggest this claim language. The Examiner has stated that paragraph [0009] of Barmettler in particular discloses this aspect of the claimed invention. This excerpt of Barmettler states that:

In accordance with the preferred embodiment of the present invention, software driver installation is automated. An automated installation object is run on a computing system. The automated installation object determines which peripheral devices are attached to the computing system. The automated installation object determines for which peripheral devices found attached to the computing system the automated installation object is able to perform automated installation. For each of these peripheral devices the automated installation object determines a network location that contains a driver installation program for the peripheral device. The automated installation object downloads the driver installation program from the network location. The automated installation object runs the driver installation program on the computing system to install a device driver for the peripheral device

The Examiner appears to have concluded that the automated installation object is one of the unattended installation file or the master driver file of the claimed invention, and that the driver installation program is the other of the unattended installation file or the master driver file of the claimed invention, such that because the object is different than the program, Barmettler in view Hamilton in view of Barmettler discloses that the unattended installation file is a different file than the master driver file. However, this conclusion is defective for at least three reasons.

First, an object is not a file. The Examiner has not explained how an object is a file, as he is required to do pursuant to his obligation to present a case of *prima facie* obviousness. However, in fact, an object is just not a file. An object is an object; a file is a file. Consider the following discussion of what an object is, and compared to what a file is, as found at http://en.wikipedia.org/wiki/Object_%28computer_science%29 and http://en.wikipedia.org/wiki/Computer_file:

In procedural programming, an object may contain data or instructions, but not both. (Instructions may take the form of a procedure or function.) In object-oriented programming, an object is an instance (or instantiation) of a class. The class object contains a combination of data and the instructions that operate on that data, making the object capable of receiving messages, processing data, and sending messages to other objects.

A computer file is a block of arbitrary information, or resource for storing information, which is available to a computer program and is usually based on some kind of durable storage. A file is durable in the sense that it remains available for programs to use after the current program has finished.

Thus, an object contains instructions, and therefore in this respect is comparable to a computer program, which also contains instructions. By comparison, a computer file stores information that is made available to a computer program. As such, one of ordinary skill within the art just does not consider an object as a file.

Second, a computer program is not a file. The Examiner has not explained how a computer program is a file, as he is required to do pursuant to his obligation to present a case of *prima facie* obviousness. However, in fact, a computer program is just not a file. As noted above, a computer file stores information that is available to a computer program. As such, one of ordinary skill within the art just does not consider a computer program as a file.

Third, the “prior art must be considered in its entirety.” (MPEP sec. 2143.01.VI) The Examiner has to weigh “what the combined teachings of the references would have suggested to one of ordinary skill in the art.” (MPEP sec. 2143.01.II) Indeed, the Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, 550 US _____ (2007), has stated that the Examiner must provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*KSR*, at 14.) Applicant submits that the Examiner did not consider the prior art in its entirety, and what the combined teaches of the references actually suggest to one of ordinary skill within the art, but rather is “picking and choosing” among the prior art to locate all the elements of the claimed invention, which is improper. That is, it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the

prior art so that the claimed invention is rendered obvious; one cannot use hindsight reconstruction to pick and choose among the prior art to deprecate the claimed invention. (In re Fritch, 972 F.2d 1260 (Fed Cir. 1992))

For instance, the Examiner previously relied upon column 3, lines 50-61 of Hamilton to disclose these limitations of the invention. However, this excerpt of Hamilton references just a single file, “[a] file” on line 50 of column 3, for instance. As such, there are not two different files, an unattended installation file and a master driver file, in contradistinction to the claimed invention. Therefore, in their entirety, the prior art teaches both the limitations of the claimed invention in question, *as well as* the *opposite* of the claimed invention. The Examiner relies upon Barmettler and ignores Hamilton in this respect simply because the former teaches the invention, even though the latter teaches the opposite of the invention. Thus, it is readily apparent that the Examiner is “picking and choosing” among the prior art to locate all the elements of the invention, using improper hindsight, and is not considering the prior art references in their entirety. That is, the Examiner has not explained why in this respect one of ordinary skill within the art would follow Barmettler and would completely disregard Hamilton, if such a person of ordinary skill does not have the benefit of impermissible hindsight.

Indeed, as has been discussed above Barmettler does not even disclose “files,” to which the claimed invention is limited, but rather discloses “an object” and “a program.” Therefore, where Hamilton teaches “a file” and Barmettler teaches “an object” and “a program,” it makes much more intuitive and logical sense that one of ordinary skill within the art would follow Hamilton and not Barmettler with respect to files. That is, where the claimed invention is limited to there being two separate files, where only Hamilton discusses a file (and only one single file at that – not two separate files), and where Barmettler does not even discuss files, one of ordinary skill within the art is likely to use a single file, as in Hamilton, and not two separate files, as in the claimed invention. In other words, the logical jump from “an object being different than a program,” which Barmettler discloses, to “there being two different files,” as the invention is

limited, is just too high to make in the obviousness analysis unless you use impermissible hindsight – at least because Hamilton itself discloses files (just like the invention), but discloses there being a single file (unlike the invention).

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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